

Attorney Docket No.: TSX 2-016-2

There is no difference between these claim limitations. Both recite a characteristic of the "torn edges". The new (and equivalent) claim language is found in the original specification, *inter alia*, as follows (emphasis supplied):

"Fig. 2 is a perspective view of the novel patterned torn or ragged open cell sponge in a conventional paint roller configuration" (page 2, ll. 22-23).

"Fig. 6 is a side elevational view of the novel torn patterned open cell synthetic sponge roller configured in a corner roller embodiment" (page 2, ll. 31-32)

"When the synthetic sponge material is composed of an open cell elastomeric material, the torn edges of the open cells are quite similar in structure to natural sea sponges." (page 3, ll. 11-13)

"In this regard, the shape or type of pattern is not critical since it is the creation of torn edges that is desired. For present purposes, then, the pattern can be random or predefined, as the creation of torn edges of the open cell foam elastomer is the effect desired." (page 3, ll. 14-17)

"It will be observed, then, that the uniqueness of the inventive torn-patterned sponge rollers have properties that can be translated to other foam rollers that are not sponge-like in nature." (page 4, ll. 3-5)

"Nevertheless, one preferred configuration of the novel torn patterned open cell synthetic sponge is in such elongate paint roller configuration. There are, however, a variety of other useful configurations for the novel torn patterned open cell synthetic sponge as those skilled in the art will appreciate based on the instant disclosure. (page 4, ll. 20-24)

Applicant could continue to recite numerous other instances where the "edges" are defined as being "torn". It also is true that the "torn edges" are "created by a tearing action", as can be found in the original specification, *inter alia*, as follows:

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"The key to mimicking natural sea sponges is not to orderly remove the material by a cutting action that would create smooth edges; but rather, to remove material by a tearing action to create ragged edges. Such ragged edges created by a tearing action yield a natural sponge-like affect when used in creating faux or rag paint finishes. In order to obtain such a tearing action, the manufacturer should avoid using sharp edged rotating cutting elements such as router bits. Rather, the manufacturer should use a simple grinding wheel that grabs the synthetic sponge material and thereby tears it. That is not to say that some "cutting" of the material does not happen, as it does. However, many of the edges are torn away by the grinding wheel. (page 3, ll. 3-10).

"Rather, it has been unexpectedly discovered that the elastomeric material should be removed by a tearing action to leave torn or ragged edges where the elastomeric material has been removed." (page 5, ll 6-8).

Again, numerous additional instances in the application can be found a support for such equivalence of language and expression. Applicant has the right to define the invention by "claiming the subject matter which the applicant regards as his invention." (35 U.S.C. § 112). Applicant has done so without ambiguity. The original expression and the new claim language are equivalent and are amply supported in the original specification and drawings. No new matter is added by these amendments and their entry respectfully is requested.

No new matter is added by virtue of the claim amendments. Moreover, such claim amendments are ministerial in nature as they relate to the formalistic structure and form of the claim language, which was seen to be clear and unambiguous by Applicant. Accordingly, Applicants assert that no claims have been narrowed with the meaning of *Festo* (*Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 56 USPQ2d 1865 (Fed. Cir. Nov. 29, 2000)).

The newly added claims also were added to the parent application. The newly added claims are based on Fig. 5 and its description at page 7, ll. 4-12. No new matter is being added and entry of these amendments respectfully requested. The additional fee due is submitted herewith.

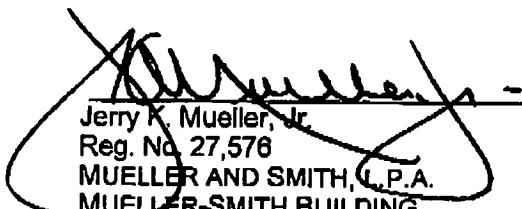
While the application describes the invention accurately and completely, perhaps, prosecution can be materially advanced by the Examiner viewing one of the novel torn, patterned sponges and comparing it to the same patterned open cell sponge roller without such torn edges. Accordingly, enclosed with the Preliminary Amendment were two rollers, one with torn edges and one without. Also, the results of rolling paint onto paper with these rollers was enclosed. The totally unique pattern created on the roller with torn, patterned edges can be visualized much easier with the enclosed samples.

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Applicant respectfully requests that the amendments presented herein be entered and that favorable action on this application be accorded. The fee due for the submission of extra claims is enclosed herewith.

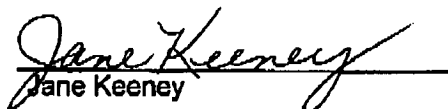
Respectfully submitted,

  
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I hereby certify that this correspondence is being deposited on May 3, 2001, with the United States Postal Service as first class mail in an envelope addressed to:

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**MARKED-UP SET OF AMENDED CLAIMS**  
**SERIAL NO. 09/344,479**

1. A patterned synthetic sponge, which comprises:  
a synthetic sponge formed from an open cell elastomeric material and bearing a pattern having ragged, torn edges, being at least about 0.5" in depth, ~~and having been created by a tearing action,~~ said patterned synthetic sponge simulating a natural sea sponge when creating faux paint finishes therewith.
20. The sponge of claim 2, wherein a pair of spaced-apart sponges surmounts said annular core.
21. A paint roller head for two-color faux finishes, which comprises:  
a pair of elongated annular sponges both of which surmount an interior annular core, said sponges formed from elastomeric material, wherein said sponges are spaced-apart, so that each said sponge is capable of being dipped into different colored paint for creating two-color faux finishes.
22. The paint roller head of claim 21, wherein said elastomeric material is selected from one or more of polyurethane, polyester, or polyether.
23. The paint roller head of claim 22, wherein said elastomeric material is an open cell elastomeric material.
24. The paint roller head of claim 21, wherein each of said sponges bears a pattern.

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